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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,899	07/21/2003	Matthew J. Newsome	014801000510	7640

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EXAMINER

LE, UYEN CHAUN

ART UNIT PAPER NUMBER

2876

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/623,899

Applicant(s)

NEWSOME ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 05/03/2006.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

***Prelim. Amdt/Amendment***

1. Receipt is acknowledged of the Amendment filed 25 April 2006.

***Allowable Subject Matter***

2. The indicated allowability of claims 9 and 20 is withdrawn in view of the newly discovered reference(s) to Lindgren et al (US 2003/0019927A1 - cited by the Applicant). Rejections based on the newly cited reference(s) follow. This Office Action is therefore made NON-FINAL.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual

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Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-11 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Lindgren et al (US 6732922 B2).

Re claims 1-11 and 17-20: Lindgren et al discloses a terminal/kiosk 114 for conducting a plurality of cashless transactions for adding value to a plurality of fare cards (fig. 1; col. 5, lines 43-46), the terminal/kiosk 114 comprising: a patron display 118 for displaying information and instructions to a patron for adding value to a fare card of the plurality of fare cards; at least one fare card reader 116 for reading from and writing to the fare card (col. 4, lines 46-60); a payment interface means comprising a debit/credit card reader for accepting as a payment mechanism, solely at least one of a credit card and a debit card (col. 5, lines 53-58); and it is inherently (otherwise the system will not work) that the system comprises a control and memory assembly for controlling the patron display, for communicating with the at least one fare card reader for reading from and writing to the at least one

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fare card to complete at least one cashless transaction of the plurality of cashless transactions, for communicating with the payment interface means to obtain debit/credit information; and for storing a history of the at least one cashless transaction in order to subsequently sent the transaction data to the server (Table 1; col.7, line 30 through col. 8, line 40) via a communications controller (col. 1, lines 65-67); wherein the plurality of fare cards comprises contactless or contactless smart cards respectively (col. 1, lines 35-41) and the fare card reader comprises a contact/contactless smart card reader 116; wherein the control and memory assembly is coupled to a transit station area controller (i.e., the server 102) (col. 4, lines 11-16), and wherein the history of the at least one cashless transaction is uploaded from the control and memory assembly to the transit station area controller at a pre-determined time, which is then stored at the server/controller (Table 1; col.7, line 30 through col. 8, line 40); wherein the fare card is a special status fare card, and wherein the control and memory assembly adds value to the special status fare card without obtaining the credit/debit information through the debit/credit card reader (i.e., the credit/debit information has already previous entered and stored in the server) (col. 3, lines 57-61 and col. 4, lines 39-45); the touch screen 118 serves as a

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plurality of selection buttons for selecting options in response to the displayed information and instructions; means for issuing a recycled fare card (i.e., update the value to the presented smart fare card via reader 116).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

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U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto et al (US 6916244 B2) in view of KAWAI (JP 06131523 A).

Re claims 12-16: Gatto et al discloses a cashless transaction terminal 300 comprises a display 326 for displaying instructions and options to a patron, a contactless card reader 306 for reading from and writing to a contactless card; a barcode reader 308 for reading the printed barcode ticket; a magnetic reader 302 for accepting at least one of a credit card and a debit card and for reading encoded data from the ID card 412 (fig. 3, lines 4, line 26 through col. 5, line 15); and a control and memory assembly for controlling the patron display, the control and memory assembly coupled to the contactless card reader and the magnetic reader for reading from the plurality of ticket/ID cards to complete a cashless transaction of the plurality of cashless transactions, the control and memory assembly for storing a history of the cashless transaction (col. 8, line 65 through col. 10, line 19).

Gatto et al is silent with respect to a magnetic reader for writing to a magnetic stripe of a card, which is utilizing the system in a transit system for adding value to fare cards.

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KAWAI teaches an automatic fare-adjusting machine comprises a display 4, a reader/writer 27 for reading/writing data from and to the magnetic film on the rear face of the ticket; and a reader/writer 60 for reading/writing data from and to a contactless ticket 50 (see English abstract and English description, paragraphs [003-004] and [0027-0045]).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a magnetic writer of Kawai into the system as taught by Gatto et al in order to provide Gatto et al with the ability of recycling the fare/ticket card by writing/updating the new/remain value to the inserted ticket/fare card, thus providing a more profit system (i.e., eliminating the use of new card). Furthermore, utilizing the system of Gatto et al in a transit system for adding/adjusting value of fare card would have an obvious extension to an artisan of ordinary skill in the art for intended use, and therefore an obvious expedient.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.



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Newly cited references to Lindgren et al, Gatto et al and Kawai have been used in the new ground of rejections to further meet the limitations of the claimed invention.

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to TAKAGI et al (JP 11156036 A) and Urata et al (US 5274218 A) are cited as of interest and illustrate a similar structure to a system for rapidly dispensing and adding value to fare cards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Uyen-Chau N. Le  
Primary Examiner  
Art Unit 2876

June 29, 2006